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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/592,910	05/14/2007	James H. Silver	CRD5075USPCT	6008

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EXAMINER

HORNBERGER, JENNIFER LEA

ART UNIT	PAPER NUMBER
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3734

MAIL DATE	DELIVERY MODE
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08/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/592,910	Applicant(s) SILVER, JAMES H.	
	Examiner JENNIFER L. HORNBERGER	Art Unit 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/15/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/13/2006, 12/22/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Forber (US 2003/0023265).

Regarding claim 1, Forber discloses a medical filter for therapeutic treatment of a patient, comprising: a first and second end defining a longitudinal axis (Fig. 1, 2, and 12); more than one pair of ribs extending between the first and second ends, the ribs tending to resiliently expand in radially outward directions from a compressed initial shape to an expanded deployed shape; wherein in the compressed initial shape, the ribs each follow a path substantially parallel to the longitudinal axis; wherein in the expanded deployed shape, the ribs each follow an undulating path, such that a first portion (L3) of each pair of ribs extends substantially adjacent to each other for a distance from the first end, and a second portion of each pair of ribs extends substantially adjacent to each other for a distance from the second end in that the ribs converge to become adjacent at the second end (Fig. 2); and an intermediate portion (L1) of each one of a pair of ribs tends to curve away from each other in the expanded deployed shape; wherein in the expanded deployed shape, the filter defines a first and second filtering portion near the first and second end, respectively.

Regarding claim 2, Forber discloses in the expanded shape, the intermediate portion (L1) of each one of a pair of ribs tends to curve away from each other and touch one of another pair of ribs (Fig. 1, 2, and 12).

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Regarding claim 3, Forber discloses in the expanded shape, a central portion of each rib tends to extend parallel to the longitudinal axis (Fig. 1, 2, and 12).

Regarding claim 4, Forber discloses the filter has at least three pairs of ribs (Fig. 1, 2, and 12).

Regarding claim 6, Forber discloses the filter is made of Nitinol (paragraph 54).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forber (US 2003/0023265). Forber fails to disclose the filter has six pairs of ribs. It would have been an obvious matter of design choice to include additional pairs of ribs, since applicant has not disclosed that the number of rib pairs solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with 3 pairs of ribs.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forber (US 2003/0023265) in view of Boyle et al (US 2003/0120303).

Forber discloses a method of making a medical filter for therapeutic treatment of a patient, comprising the steps of: providing a tubular form defining a longitudinal axis and having a first and second end; at least one pair of struts in the tubular form, so as to define the struts extending between a first and second end of the filter; and treating the struts so that they tend to resiliently expand from a compressed shape to an expanded shape (paragraph 54); by expanding a central portion of the struts in radially outward directions; such that a gap is defined between the pairs of struts, and the individual struts of each pair follow a path which is

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substantially adjacent to the other strut of that pair; and by bending a central portion of each of the ribs to follow an undulating path in the expanded shape, such that in the expanded shape a first portion (L3) of each pair of ribs extends substantially adjacent to each other for a distance from the first end, and a second portion of each pair of ribs extends substantially adjacent to each other for a distance from the second end; wherein an intermediate portion (L1) of each one of a pair of ribs is bent to curve away from each other in the expanded shape; the filter defines a first and second filtering portion near the first and second end, respectively (Fig. 1, 2, and 12).

Forber fails to disclose cutting the tubular form to create the more than one pair of struts. Boyle et al. disclose providing a tubular form defining a longitudinal axis and having a first and second end, laser cutting more than one pair of struts in the tubular form so as to create a desired pattern defining the struts extending between the first and second end of the filter, and treating the struts so that they tend to resiliently expand from a compressed shape to an expanded shape (paragraph 51). It would have been obvious to one of ordinary skill in the art to have formed the filter of Forber by laser cutting a tubular form to create the desired strut pattern since Boyle et al. has disclosed it is a well known technique in the art for forming self-expandable filters.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER L. HORNBERGER whose telephone number is (571)270-3642. The examiner can normally be reached on Monday through Friday from 8am-5pm, Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571)272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlh

08/03/2009

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3734